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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,847	10/14/2003	James F. Zucherman	SFMT-01056USD	3522
23910	7590	05/17/2007		
FLIESLER MEYER LLP 650 CALIFORNIA STREET 14TH FLOOR SAN FRANCISCO, CA 94108			EXAMINER PHILOGENE, PEDRO	
			ART UNIT 3733	PAPER NUMBER
			MAIL DATE 05/17/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/684,847

Applicant(s)

ZUCHERMAN ET AL.

Examiner

Pedro Philogene

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5-7, 14-16, 21-29, 34-36, 40, 41 and 46-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-29 is/are allowed.
- 6) ☒ Claim(s) 5-7, 14-16, 34-36 and 46-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 6/25/04, 2/12/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 5,14-16,34,46,48 are rejected under 35 U.S.C. 102(b) as being anticipated by Larsen et al. (5,782,832).

With respect to claims 5,14-16, 34, 46,48, Larsen et al disclose an implant (400) adapted to be placed between spinous processes comprising a spacer that is adapted to fit between spinous processes, the spacer including a first portion (402) and a second portion (404) pivotally connected at a hinge (432); and a threaded screw (418) arranged in a plane with the hinge (432) and an actuatable spreading device (412) rotatably mounted on the threaded screw to adjust the height of the spacer in order to adjust the spacing between the spinous process. The mechanism of the implant further comprises a screw arranged generally perpendicular to the shaft and an actuatable spreading device (412) engaging threads of the screw; as best seen in FIG.22; a tissue expander (402,404) extending from the distal end of the shaft; the spacer has an adjustable profile; as set forth in column 8, lines 8-47 and as best seen in FIGS.21-24.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 6,7,35,36,40,41,47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larsen et al. (5,782,832).

Larsen et al disclose an implant (400) adapted to be placed between spinous processes comprising a spacer that is adapted to fit between spinous processes, the spacer including a first portion (402) and a second portion (404) pivotally connected at a hinge (432); and a threaded screw (418) arranged in a plane with the hinge (432) and an actuatable spreading device (412) rotatably mounted on the threaded screw to adjust the height of the spacer in order to adjust the spacing between the spinous process. The mechanism of the implant further comprises a screw arranged generally perpendicular to the shaft and an actuatable spreading device (412) engaging threads of the screw; as best seen in FIG.22; a tissue expander (402,404) extending from the distal end of the shaft; the spacer has an adjustable profile; as set forth in column 8, lines 8-47 and as best seen in FIGS.21-24.

It is noted that Larsen et al did not teach of an adjusting means including a slotted sphere; as claimed by applicant. However, the slotted sphere shape of the adjusting means is one of numerous configurations a person of ordinary skill in the art would find obvious for the purpose of providing mating surfaces in the adjusting means and the first and second portions of the spacer. See in re Dailey, 149 USPQ 47 (CCPA 1976).

Allowable Subject Matter

Claims 21-29 are allowed.

Response to Amendment

Applicant's arguments, see Remarks, filed 3/15/07, with respect to the rejection(s) of claim(s) 5-7,14-16,34-36,40,41,46-48 under 103 have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made in view of Larsen et al.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

6,368,351	4-2002	Glenn et al.
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6,454,807	9-2002	Jackson
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Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Pedro Philogene
May 7, 2007


PEDRO PHILOGENE
PRIMARY EXAMINER